

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-3, 5-7 and 9-11 are now present in this application. Claims 1, 7 and 10 are independent. Claims 4, 8 and 12 have been canceled, and claims 1-3, 5-7 and 9-11 have been amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants respectfully request that the Examiner acknowledge Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document in the National stage Application from the International Bureau.

Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the Information Disclosure Statement filed February 1, 2005, and for providing Applicants with an initialed copy of the PTO-1449 form filed therewith.

Rejection Under 35 U.S.C. § 102

Claims 1-2, 7-10 and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,496,262 to Johnson et al. ("Johnson '262"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, Applicants note that this rejection is moot with respect to claims 8 and 12, which have been canceled.

During patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). This burden can be satisfied when the PTO presents evidence, by means of some teaching, suggestion or inference either in the applied prior art or generally available knowledge, that would have appeared to have suggested the claimed subject matter to a person of ordinary skill in the art or would have motivated a person of ordinary skill in the art to combine the applied references in the proposed manner to arrive at the claimed invention. See Carella v. Starlight Archery Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); In re Rinehart, 531 F.2d 1048, 1051-1052, 189 USPQ 143, 147 (CCPA 1976).

If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability vel non is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherence may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Claim 1, as amended, recites a combination of features, including an inflatable bladder having volume-reducing internal component means for dissipating the flow of fluid into the bladder with accompanying reduction in fluid flow rates and noise generated by the fluid flow during pressurization of the bladder in a timed sequence of pressure hold and pressure release.

Johnson '262 does not disclose this claimed combination of features. While Johnson '262 does include two urethane foam layers 34, Johnson '262, in col. 2, lines 30-40, discloses those urethane foam layers in the context of U.S. Patent 4,628,945 ("Johnson '945"). Johnson '945 discloses urethane foam layers in the context of an inflatable device that is filled up with air by mouth (see the paragraph bridging cols. 2 and 3) and discloses that these layers are used as protective cushions to avoid discomfort to the wearer (see col. 4, lines 37-50).

There is absolutely no explicit disclosure in either Johnson '262 or Johnson '945 of an inflatable bladder having a volume-reducing internal component means for dissipating the flow of fluid into the bladder with accompanying reduction in fluid flow rates and noise generated by the

fluid flow during pressurization of the bladder in a timed sequence of pressure hold and pressure release, as claimed.

Nor does the Office Action make out a *prima facie* case of inherent disclosure of the claimed invention. As pointed out in the case law cited above, for the office to show inherent disclosure, what is inherent must not just possibly occur, and must not just probably occur, but must necessarily occur. The Office Action clearly provides no objective factual evidence that the layers 32 of urethane foam in Johnson '262 necessarily constitute volume-reducing internal component means for dissipating the flow of fluid into the bladder with accompanying reduction in fluid flow rates and noise generated by the fluid flow during pressurization of the bladder in a timed sequence of pressure hold and pressure release, as claimed, especially where the primary disclosed purpose of those urethane layers 32 is for the comfort of the wearer.

With respect to independent claim 7, this claim positively recites a combination of features including a flexible pad having an inflatable interior filled or partially filled with a cellular component providing means for reducing fluid flow rates and noise during pulsed pressurization of said inflatable interior of the flexible pad.

Applicants respectfully submit that the arguments presented above directed to the subject matter of claim 1 apply equally to claim 7, there being absolutely no explicit or inherent disclosure in Johnson '262 of a flexible pad having an inflatable interior filled or partially filled with a cellular component providing means for reducing fluid flow rates and noise during pulsed pressurization of said inflatable interior of the flexible pad. The concept of using such a pad for reducing fluid flow

rates and noise reduction during in a timed sequence of pressure hold and pressure release regarding the inflatable interior of the flexible pad is completely absent from Johnson '262.

With respect to independent claim 10, this claim positively recites a combination of features including a flexible pad having an inflatable chamber having means for controlling fluid flow rates and noise level during pressurization of the inflatable chamber by varying the internal volume of the inflatable chamber.

Applicants respectfully submit that the arguments presented above directed to the subject matter of claim 1 apply equally to claim 10, there being absolutely no explicit or inherent disclosure in Johnson '262 of a flexible pad having an inflatable chamber having means for controlling fluid flow rates and noise during pressurization of the inflatable chamber by varying the internal volume of the inflatable chamber. The concept of using such a pad for reducing fluid flow rates and noise reduction during pressurization which is applied in a timed sequence of pressure hold and pressure release is completely absent from Johnson '262.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of the invention recited in claims 1-2, 7-10 and 12.

Reconsideration and withdrawal of this rejection of claims 1-2, 7-10 and 12 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 3 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson '262 in view of U.S. patent 4,135,500 to Gorran. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. §103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the

prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembicza, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicants respectfully submit that Johnson '262 does not anticipate the subject matter of claim 1 from which claim 3 depends, or claim 10 from which claim 11 depends, so even if it one of ordinary skill in the art were properly motivated to modify Johnson '262 in view of Gorran (which is not the case for reasons explained, below), as suggested, the resulting modified version of Johnson '262 would not suggest or render obvious the claimed invention.

Moreover, the Office Action fails to provide any objective factual evidence that one of ordinary skill in the art would be properly motivated to turn to Gorran to modify Johnson '262 for a number of reasons.

Firstly, Johnson '262 and Gorran are quite different and are not concerned with solving the same problem. Johnson '262 is concerned with an intermittently pressurized multicomponent cuff for therapeutic treatment of human body parts, where the cuff includes urethane layers inside the cuff for comfort of a wearer of the therapeutic cuff, whereas Gorran is concerned with an air mattress

flotation support system 10 that rests on, not inside of, an air bladder, and is raised up and down by the air in the air bladder.

Secondly, the Office Action fails to provide objective factual evidence that replacing urethane foam layers 34 by a gel inside of the Johnson '262 cuff will achieve the patient cushioning and compression provided by a urethane foam layer, especially since the gel in Gorran is freely dispersible throughout the element 10 of Gorran.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 3 and 11 are respectfully requested.

Claims 4-5 stand rejected under 35 USC §103(a) as being unpatentable over "Johnson '262 in view of Johnson '262." This rejection is respectfully traversed.

Initially, Applicants note that this rejection is unclear to the point that it is not capable of being understood. The statement of the rejection is based on a base reference in view of a secondary reference, but identifies the same reference as the base reference and the secondary reference. Moreover, the body of the rejection does not further clarify the basis for the rejection, either, as it merely discusses "Johnson '262." As such, the rejection is fatally flawed and must be withdrawn.

Clarification is respectfully requested.

Applicants realize that two different patents to Johnson are cited on the List of References Cited, i.e., on Form PTO-892, i.e., U.S. Patent 5,496,262 ("Johnson '262") and U.S. Patent 5,558,955 ("Johnson '955"). Perhaps one cited Johnson reference was intended to be the primary reference and the other Johnson reference was intended to be the secondary reference. However, it is not clear from the Office Action which Johnson reference was applied as the primary reference and which Johnson reference was intended to be the secondary reference.

Before Applicants can be expected to respond to the merits of this rejection, the Examiner must clarify whether the rejection is based on two separate references, identify both references accurately, identify which is the primary reference and which is the secondary reference, explain how the primary reference is supposed to be modified in view of the secondary reference, and provide objective factual evidence of proper motivation for one of ordinary skill in the art to modify the primary reference in view of the secondary reference.

Nevertheless, in the interest of being completely responsive to these unclear rejections, Applicants respectfully point out that Johnson '262 does not anticipate claim 1, from which both claims 4 and 5 depend, and does not anticipate claim 2, from which claim 5 depends, for reasons presented above.

Nor is the secondary reference, whether it is Johnson '262 or Johnson '955, applied to remedy the aforenoted deficiencies in Johnson '262.

Accordingly, even if one of ordinary skill in the art were properly motivated to modify the base reference in view of the secondary reference (which is not the case, for reasons discussed

below), the resulting modified version of the base reference would not render obvious the claimed invention.

With respect to the issue of proper motivation, the Office Action merely concludes that either component (without identifying both components) could be used to reduce volume in an inflatable bladder. This is nothing more than a broad conclusory statement about the teaching of multiple references that does not constitute evidence of proper motivation- see the “Dembiczak” case, cited above.

Under the circumstances, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of obviousness of claims 4-5.

Reconsideration and withdrawal of this rejection of claims 4-5 are respectfully requested.

Claim 6 stands rejected under 35 USC §103(a) as unpatentable “over the references as applied to claims above, and further in view of Grim ‘525.’” This rejection is respectfully traversed.

Because claim 6 depends from claim 5 and because the rejection of claim 5 is so unclear that it is also not capable of being understood, this rejection is also not capable of being understood. As such, the rejection is fatally flawed and must be withdrawn.

Clarification is respectfully requested.

Turning to the merits of the rejection, Applicants respectfully incorporate herein the reasons from the traversal of the aforementioned rejection of claims 4 and 5, above.

Furthermore, the Office Action fails to provide any objective factual evidence that one of ordinary skill in the art would be properly motivated to turn to Grim to modify the only identified

single one of two references on which this rejection is based, because Johnson '262 and Grim are so different (a rapidly constantly inflated and deflated therapeutic cuff and an infrequently inflatable shoe) and are not concerned with solving the same problem. Johnson '262 is concerned with an intermittently pressurized multicomponent cuff for therapeutic treatment of human body parts, where the cuff includes urethane layers inside the cuff for comfort of a wearer of the therapeutic cuff, whereas Grim is concerned with an athletic shoe that does simply not have the intermittent pressurization and de-pressurization aspect Johnson '262.

Under the circumstances, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of obviousness of claim 6.

Reconsideration and withdrawal of this rejection of claim 6 are respectfully requested.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response

Application No.: 10/523,023
Art Unit 3764

Attorney Docket No. 4140-0112P
Reply to Office Action dated June 13, 2006
Page 18

has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Applicants also note that because the rejections of claims 4-6 are completely unclear to the point of not being comprehensible enough to fully respond to on their merits, they must be withdrawn and any further rejections of claims 4-6 cannot properly be made final.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Jr., Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

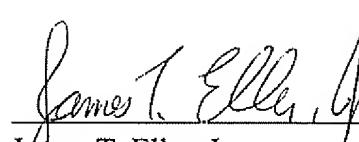
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:


James T. Eller, Jr.
Reg. No.: 39,538

JTE/RJW/cdr 

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000